

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. Amendments to the Claims

Claims 6, 10, and 12 are currently amended. In particular, claim 6 is amended to recite a reagent “that is reactive to a hydroxyl group to form a hydroxyl-protecting group,” and the hydroxyl-protecting group is given as formula (II). Exemplary support for this amendment can be found in the original claims. In addition, claims 10 and 12 are amended to state that X is “F, Br, or I”, rather than “a halogen atom.” Exemplary support for this amendments can be found in the paragraphs starting at page 2, line 27, and page 5, line 5.

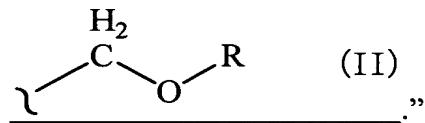
Finally, claims 14-15 are added. Exemplary support for new claims 14-15 can be found throughout the Specification, for example, in the paragraph starting at page 2, line 14, and the paragraph starting at page 10, line 12.

As the foregoing amendments do not introduce new matter, entry thereof by the Examiner is respectfully requested. After amending the claims as set forth above, claims 1-15 are now pending in this application.

II. Claim Rejections 35 U. S. C. §102

Claims 6-9 are rejected under 35 U.S.C. 102(b) as being allegedly anticipated by Gu et al. (J. Org. Chem., Vol. 51 (26), 1986, 5425-5427). Applicants respectfully traverse this ground for rejection.

Claim 6 is amended to recite a “reagent that is reactive to a hydroxyl group to form a hydroxyl-protecting group”, wherein the hydroxyl-protecting group is represented by the formula (II):



Gu teaches the use of 2-(chloromethyl)-3,5-dioxahex-1-ene as an intermediate for acetylation of alcohols. This reference fails to teach a hydroxyl-protecting group a represented by formula (II), as recited in amended claim 6. Claims 7-9 depend from claim 6, and therefore also require this limitation. For at least this reason, Gu fails to teach the claimed invention and, therefore, withdrawal of this ground for rejection is respectfully requested.

III. Claim Rejections 35 U. S. C. § 103

Claims 1-13 are rejected under 35 U.S.C. 103 (a) as being allegedly anticipated by Gu et al., J. Org. Chem. (Vol. 51 (26), 1986, 5425-5427), in view Beauchamp et al. (J.Med. Chem., 31 (1), 1988, 144-149), and further in view of Horino et al. (US Patent No. 5,739,100). Applicants respectfully traverse this ground for rejection.

A. The Rejection of claims 1- 5 should be withdrawn

Claim 1 is directed to a method of protecting a hydroxyl group, comprising reacting a hydroxyl group-containing compound with a compound represented by the formula (I) “in the presence of an acid catalyst to substitute the hydrogen atom of the hydroxyl group of the hydroxyl group-containing compound with a protecting group represented by the formula (II).”

In contrast to Applicants’ invention as defined by claim 1, Gu teaches reacting 2-(chloromethyl)-3,5-dioxahex-1-ene with alcohol by multiple steps (1) under basic condition, and (2) acidic condition, to form acetylated alcohols. Such compounds clearly do not comprise a protecting group represented by Applicants’ formula (II).

Beauchamp and Horino are cited for disclosing other features of the claims but both references fail to cure the deficiencies of Gu, as explained above. Thus, even if Gu, Beauchamp and Horino were combined, the combination would not teach or suggest all of the features of Applicants’ claim 1.

Claims 2-5 depend on claim 1, and are thus patentable for at least the same reasons.

B. The Rejection of claims 6- 9 is moot & new claims 14-15 depending from claim 6 are patentable:

As explained above, Gu does *not* disclose a reagent that is reactive to a hydroxyl group to form a hydroxyl-protecting group, wherein the hydroxyl-protecting group is represented by formula (II), as recited in amended claim 6.

Beauchamp and Horino are cited for disclosing other features of the claims but the references fail to cure the deficiencies of Gu explained above. Thus, even if Gu, Beauchamp and Horino were combined, the combination would not teach or suggest all of the features of claim 6.

Claim 7-9 depend from claim 6, and are thus patentable for at least same reasons. Claims 14-15, which are added to further define the reagent, depend from claim 6, and thus are patentable for at least same reasons.

C. The Rejections of claims 10- 13 are moot:

Claims 10 and 12 are amended to recite “X is F, Br, or I.”

Gu teaches 2-(chloromethyl)-3,5-dioxahex-1-ene, and Beauchamp teaches 2-chloro-1-(chloromethyl) ethyl methoxymethyl ester. However, both references fail to teach “a method of producing a compound represented by the formula (I)... wherein X is F, Br, or I.”

Horino is cited for disclosing other features of the claims. However, this reference fails to cure the deficiencies of Gu and Beauchamp.

Claim 11 depends from claim 10, and claim 13 depends from claim 12, and are thus patentable for at least same reasons.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

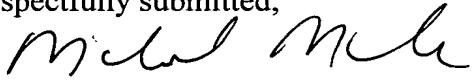
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Date Aug 4, 2008

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

Respectfully submitted,


By Reg. No. 34,717


Stephen B. Maebius
Attorney for Applicants
Registration No. 35,264